

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

Claims 27, 29, 30 and 36 stand rejected under 35 USC 112, first paragraph as allegedly failing to comply with the written description requirement. In order to obviate this rejection, the term "rebranding" has been removed, and these claims now define packaging... the order... in branded packaging". Support for this specific language is found in the specification page 14 lines 10-12.

The point made in the official action about analyzing orders as compared with analyzing shipments and sales information is certainly understood; however, the ordering in claim 26 is defined as receiving payment information. Since the payment information is indicative of the orders which have been received, claims 29 and 30 have been amended to recite this which hence obviates this interpretation.

Claims 27 and 36 stand rejected under 35 USC 112, second paragraph, as being indefinite. Claim 27 specifies receiving an order at a server, and packaging the order. To obviate any confusion about which structure is carrying this out,

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

these claims have been amended to clarify that this is based on information received from the server.

Claims 21-23 and 25-36 stand rejected under 35 USC 102b as allegedly being anticipated by Rothman 'Rothman.

Claim 21 has been amended to include the limitations of claims 22 and 25 therein. As amended, this claim defines the inventory management system, and also defines that when a return is made to a retailer other than the retailer who sent the product, using that refund to increase an indication of a number of items stored at the retailer in the inventory management system. The rejection states that this is shown by Rothman, who states that the retailer can "keep the returned product for resale". However, Rothman does not say or recognize anything about changing the status of the inventory management system based on the return. Presumably, when a return is made in Rothman, that return simply gets kept by the retailer, so that the retailer can resell the product. Rothman says nothing about updating the inventory management system. Hence, the returned product would presumably only be sellable by the one retailer who has it -- not by others, as would be the case as in claim 21 where the inventory management was updated to indicate the returned product at the retailer.

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

In any case, nothing in Rothman says anything about “using said refund of said item to increase an indication of a number of items stored at said retailer in said inventory management system”, as claimed. Therefore, claim 21 should be allowable for these reasons, since this is not disclosed by Rothman.

Claim 26 is also amended into independent form, where claim 26 defines that the order fulfillment locations have different brands than a brand associated with the server and the order fulfillment location receives the brand associated with the server. The abstract of Rothman simply says that retailers can sell branded products, but does not say anything about receiving the brand associated with the server, as in claim 26.

Claim 27 is even further allowable, since it defines packaging the order in branded packaging at the order fulfillment location. The rejection attempts to read this on the “hearts on fire diamond ...that is locally sold”. However, with all due respect, nothing in Rothman provides any disclosure of using “branded packaging” as claimed.

Therefore, claim 27 should be additionally allowable.

Claim 29 should also be additionally allowable, as it defines analyzing information indicative of orders to determine product trends based on geography (claim 29) or based on demographics (claim 30). The rejection attempts to read

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

this on sales and commissions for compensation purposes. However, this turns the term “product trends” on its head, and, with all due respect, is not a proper reading of the claim terms or the prior art.

New claims 37 and 38 are also presented herein which define analogous subject matter and hence should be allowable for analogous reasons.

As an initial matter, it is respectfully noted that as a matter of law, the patent office cannot simply take the broadest interpretation of the claims in a vacuum. Rather, the patent office must take the broadest reasonable interpretation of the claims that is consistent with the specification, and as it would be understood by one having ordinary skill in the art. [*Phillips v. AWH Corp.* 363 F.3d 1207, (Fed. Cir. 2005, *en banc*) “The Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art”]

According to the *Phillips* case, the patent office must consider how terms would be understood by those having ordinary skill in the art reading the specification. Certainly one having ordinary skill in the art would not believe that monitoring information for commission compensation purposes was the same as determining product trends based on geography or demographics. Those having

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

ordinary skill in the art would understand that these are two are wholly different.

Therefore, these claims should be additionally allowable.

Claim 31 defines branded packaging, which is nowhere disclosed or otherwise made obvious by the cited prior art. Therefore, claim 31 should be allowable on its own merits.

Claim 34 has been amended to include similar limitations to those now inserted into claim 21, and should be allowable for similar reasons. Specifically, nothing in Rothman discloses using the refund to increase an indication of the number of items stored at the retailer in an inventory management system.

Claim 24 stand rejected over Rothman in view of Borders. This claim should be allowable by virtue of its dependency.

Claim 24 was rejected under 35 USC 102 as being obvious over Rothman in view of Borders. This contention is further respectfully traversed.

In addition, however, claim 24 defines that the order fulfillment location determination carries out a determination of finding a location (from among the various locations) that has a specified mailing time to the consumer. The rejection admits that this is not disclosed or suggested by Rothman. Borders shows a number of stores and servers related with those stores. While Borders shows that a user can set a specified delivery destination day, this does not disclose that this

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

will set different different locations to mail the items. Basically, the user can select when they want the delivery to occur, and this will relate to that kind of delivery method which is used. See Borders' paragraph 145 which specifies the delivery routes and stops, rather than specifying a different item part or whatever to send the information from. In fact, the distribution center describes beginning paragraph 221 discloses nothing about a number of different distribution centers and certainly nothing about the specific claimed feature that order fulfillment location from the plurality of order fulfillment locations based on a specified mailing time to the user. Hence the combination of Rothman in view of Borders shows a Rothman type system with Borders' teaching of different delivery techniques. There is no disclosure of a sending from one of different areas. Claim 24 should hence be further allowable.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance. A formal notice of allowance is hence respectfully requested.

If the Examiner believes that communications such as a telephone interview or email would facilitate disposal of this case, the undersigned respectfully encourages the Examiner to contact the undersigned.

Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail (using the email address harris@schiplaw.com). I understand that a copy of these communications will be made of record in the application file.

Please charge any fees due in connection with this response, (other than those concurrently paid via EFS), to Deposit Account No. 50-4376, small entity.

Respectfully submitted,

Date: 8/3/2009 _____ /Scott C Harris/ _____

Scott C. Harris
Reg. No. 32,030

Appl. No. : **09/710,690**
Filed : **December 10, 2000**

Customer No. 74162
Scott C. Harris, Esq.
Law Office of Scott C Harris, Inc
PO Box 1389
Rancho Santa Fe, Ca 92067
Telephone: (858) 756-7778
Facsimile: (858) 756-7717